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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,915	08/31/2000	DARRYL BLACK	102689-51	4244
21125	.7590	03/11/2004	EXAMINER	
NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			KHOSRAVAN, JIMAN	
			ART UNIT	PAPER NUMBER
			2141	3

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/651,915

Applicant(s)

BLACK ET AL.

Examiner

Jiman Khosravan

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The information disclosure statement filed January 5, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Although Applicant states that legible copies of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed have been previously submitted with United States Patent Application Number 09/637,800 filed on August 11, 2000, there are multiple Continuation-in-Parts (CIPs) of that application and further copies are necessary. Therefore, legible copies of

documents CA-CR are required for the consideration of the information disclosure statement filed January 5, 2001, but US and Foreign Patent documents AA-AV and BA-BG, respectively, are not required.

### ***Drawing Objections***

3. Formal drawings are required to be submitted by the applicant.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-3, 5-7, 9-14, and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/653419. Although the conflicting

claims are not identical, they are not patentably distinct from each other because the difference between the claim languages is “screen mark,” instead of “custom wizard,” wherein a “screen mark” can be a “custom wizard.”.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections ~ 35 U.S.C. § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is not complete as the last word of the claim is “and.”

***Claim Rejections ~ 35 U.S.C. § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-2, 4-12, and 15-16, are rejected under 35 U.S.C. 102(e) as being anticipated by Falcon et al. (US 6,295,556).

a) As per claim 1, Falcon discloses a method of managing a telecommunications network, comprising of presenting a graphical user interface (GUI) to a user (Col. 1, lines 52-54 & 62-64; Col. 4, lines 57-63), including providing a plurality of screen marks (Figure 6; plurality of connection objects which employ heterogeneous connectoids: Col. 6, lines 53-63) and jumping to a GUI screen corresponding to a first one of the plurality of screen marks in response to the user's selection of the first screen mark (Figures 6 & 7; Col. 7, lines 1-26: Each connection object has a General tab, Logon, Options, Advanced, and Permissions tab. The interface of Figure 6 is the entry point of the user to the GUI screen corresponding to the plurality if screen mark chosen)

b) As per claim 2, Falcon discloses the claimed invention as above and further discloses jumping to a GUI screen corresponding to a second one of the

plurality of screen marks in response to the users' selection of the second screen mark Figures 6 & 7).

c) As per claim 4, Falcon discloses the claimed invention as above and further discloses wherein at least one of the screen marks comprises a default screen mark (Figure 6: "New Connector"; Col. 5, lines 51-63: Some settings are kept hidden from users because they are too trouble some if the user does not have the technical expertise to deal with some features).

d) As per claim 5, Falcon discloses the claimed invention as above and further discloses wherein at least one of the screen marks comprises a custom screen mark (Figure 6: "Office").

e) As per claim 6, Falcon discloses a network management system, comprising a graphical user interface (GUI) including a custom navigator tool (Col. 1, lines 52-54 & 62-64; Figure 7).

f) As per claim 7, Falcon discloses the claimed invention as above and further discloses wherein the GUI further includes a plurality of screen marks (Figure 6: "Office," Work From Home," & "MSN").

g) As per claim 8, Falcon discloses the claimed invention as above and further discloses wherein the plurality of screen marks includes at least one default screen mark (Figure 6: "New Connector"; Col. 5, lines 51-63: Some settings are

kept hidden from users because they are too trouble some if the user does not have the technical expertise to deal with some features).

h) As per claim 9, Falcon discloses the claimed invention as above and further discloses wherein at least one of the screen marks comprises a custom screen mark (Figure 6: "Office").

i) As per claim 10, Falcon discloses a method of managing a telecommunications network, comprising of displaying a graphical user interface (GUI) screen in response to input from a user (Col. 1, lines 52-54 & 62-64; Col. 4, lines 57-63), receiving a screen mark selection from the user (Figures 6 & 7; Col. 7, lines 1-26: The interface of Figure 6 is the entry point of the user to the GUI screen (Figure 7) corresponding to the plurality if screen mark chosen), and creating a custom screen mark in response to the screen mark selection (Figure 6; Col. 5, lines 64-67; Col. 6, lines 1-28: "Office" is the newly created screen mark after it is saved and stored to non-volatile storage).

j) As per claim 11, Falcon discloses the claimed invention as above and further discloses wherein after receiving a screen mark selection from the user, the method further comprises prompting the user to input a screen mark name, receiving a screen mark name from the user, and wherein creating a custom screen mark in response to the screen mark selection includes naming the custom screen



mark with the screen mark name received from the user (Col. 2, lines 5-14; Col. 6, lines 15-29).

k) As per claim 12, Falcon discloses the claimed invention as above and further discloses wherein at least one of the screen marks comprises a custom screen mark (Figure 6: "Office").

l) As per claim 15, Falcon discloses the claimed invention as above and further discloses wherein the other screen marks include at least one default screen mark (Figure 6: "New Connector"; Col. 5, lines 51-63: Some settings are kept hidden from users because they are too trouble some if the user does not have the technical expertise to deal with some features).

m) As per claim 16, Falcon discloses the claimed invention as above and further discloses detecting a selection of the custom screen mark by the user (Figures 6 & 7: Col. 7, lines 1-26: The interface of Figure 6 is the entry point of the user to the GUI screen (Figure 7) corresponding to the plurality if screen mark chosen).

### ***Claim Rejections ~ 35 U.S.C. § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falcon, and further in view of McNally et al. (US 6,384,850).

As per claims 3, 13, and 14, Falcon discloses the claimed invention as above and further discloses a listing of plurality of screen marks displayed in a user interface. However, Falcon does not explicitly teach using a pull-down menu to display and list the screen marks.

McNally discloses through an interface of windows, pull-down menus, and toolbars, a GUI for accessing user applications (Col. 4, lines 59-66). By implementing the pull-down menu of McNally in the system of Falcon, Falcon would have displayed the screen marks in a different manner, giving the user different options in viewing the screen marks.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of McNally in the system of Falcon because by implementing the specification as described above, the GUI operating

system would have become more user friendly by eliminating the need to memorize keyboard entry sequences (Col. 4, lines 59-66).

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jiman Khosravan whose telephone number is (703) 305-0704. The examiner can normally be reached on Monday - Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rupal.dharia@uspto.gov].

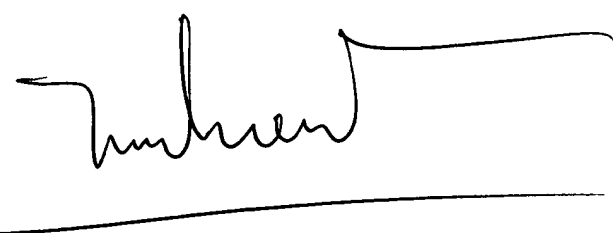
All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality

requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jiman Khosravan  
Examiner  
Art Unit 2141

  
March 1, 2004

  
LE HIEN LUU  
PRIMARY EXAMINER